

A / Reissue

PATENT
Our File: WILL 2501

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of:

BILL DAVIS and JESSE S. WILLIAMSON

For Reissue of U. S. Patent 5,630,363

Issued May 20, 1997

Serial No. 08/515,097

Filing Date: May 20, 1999

Serial No.: _____

For: **COMBINED LITHOGRAPHIC/
FLEXOGRAPHIC PRINTING
APPARATUS AND PROCESS**

Group Art Unit: _____

Examiner: _____

REISSUE APPLICATION TRANSMITTAL LETTER

TO: The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

SIR:

Transmittal herewith for filing is the Reissue Application of Bill L. Davis and Jesse S.

Williamson pursuant to 35 U.S.C. §§251 et seq. and 37 C.F.R. §§1.171 et seq. Enclosed are:

1. Application for Reissue of U.S. Patent 5,630,363 Under 35 U.S.C. §251 and 37 C.F.R. §1.171;
2. Reissue Declaration of Bill L. Davis and Jesse S. Williamson;
3. Submission of Cut-Up Specification and Drawings Under 37 C.F.R. §1.173;
4. Assignee's Offer to Surrender U.S. Patent 5,630,363;
5. Order for Title Report;
6. Declaration and Power of Attorney;
7. Assent of Assignee for Reissue of U.S. Patent 5,630,363;
8. Statement of Prior Art and Other Information, PTO-1449 forms (modified) and Binder of Appendices;
9. Binder of Prior Art and Other Information (Tabbed Appendix);
10. Petition to Expunge Under 37 C.F.R. §1.59(b) and M.P.E.P. 724.05;
11. Check in the amount of \$3,292.00 to cover filing and petition to expunge fees;
12. Certificate of Express Mailing; and
13. Self-Addressed, stamped postcard.

REISSUE APPLICATION TRANSMITTAL LETTER

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FOR	NO. FILED	NO. EXTRA	RATE	FEE
Reissue Application Filing Fee, Basic Fee, Fee Code 108			\$760.00	\$760.00
Reissue <u>Independent</u> Claims Over Those in Patent, Fee Code 109	10 more	13	\$78.00	\$1,014.00
Reissue Claims in Excess of Twenty and Patent, Fee Code 110	(20 + 26) = 46	46	\$18.00	\$828.00
Multiple Dependent Claim Presented, Fee Code 104		2	\$260.00	\$560.00
Petition to Expunge - § 1.17(i) fee per 37 CFR § 1.59(b)			\$130.00	\$130.00

TOTAL ADDITIONAL FEE FOR THIS AMENDMENT		\$3,292.00
<input type="checkbox"/> No additional fee is required. <input checked="" type="checkbox"/> A check in amount of \$3,292.00 is attached. <input checked="" type="checkbox"/> Please charge any additional fees or credit overpayment to Deposit Account No. 06-0075. A duplicate copy of this sheet is enclosed.		

Respectfully submitted,


Robert Hardy Falk

Robert Hardy Falk
Registration No. 27,877
FALK & FISH, L.L.P.
700 North Pearl Street, Suite 970
Dallas, Texas 75201
Telephone: (214) 954-4400
Facsimile: (214) 969-5941

ATTORNEYS FOR APPLICANT
WILLIAMSON PRINTING CORPORATION,
a Texas Corporation

PATENT
Our File: WILL 2501

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of: §
 BILL L. DAVIS and JESSE S. WILLIAMSON §
For Reissue of U. S. Patent 5,630,363 § Group Art Unit: _____
 Issued May 20, 1997 §
 Serial No. 08/515,097 §
Filing Date: May 20, 1999 § Examiner: _____
Serial No.: _____ §
For: **COMBINED LITHOGRAPHIC/** §
 FLEXOGRAPHIC PRINTING §
 APPARATUS AND PROCESS §

APPLICATION FOR REISSUE OF U.S. PATENT 5,630,363
UNDER 35 U.S.C. §251 AND 37 C.F.R. §1.171

TO: The Honorable Commissioner of
 Patents and Trademarks
 Washington, D.C. 20231

SIR:

Pursuant to the captioned provisions of Title 35, U.S. Code and Title 37, Code of Federal Regulations, Petitioners Bill L. Davis and Jesse S. Williamson, the original first and joint inventors of the invention described and claimed and of the discovery described in U. S. Patent 5,630,363 ("the '363 patent") and their assignee, Williamson Printing Corporation, seek reissue of the '363 patent, *inter alia*, for the following reasons:

I.

ERRORS AND POTENTIAL ERRORS

Petitioners believe that, because of what might be deemed errors in the specification and claims of U.S. Patent 5,630,363, that the '363 patent might be inoperative or invalid (a) by reason of Petitioners claiming in some instances more, and in some instances less, than they had

APPLICATION FOR REISSUE OF U.S. PATENT 5,630,363
UNDER 35 U.S.C. §251 AND 37 C.F.R. §1.171

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a right to claim in the '363 patent, or (b) for the reason that the '363 claims might be interpreted as failing to particularly point out and distinctly claim the subject matter which the Petitioners regarded as their invention. Reissue Decl., ¶2. There also exist certain errors in the specification including, but not limited to, minor stenographical errors. Petitioners have declared that all of these errors sought to be corrected arose through their unfamiliarity with U. S. patent practice, and/or through inadvertence, and were all without any deceptive intention. Petitioners seek to correct these errors through amendments to their specification and claims, and endorse the amendments set forth in their cut-up specification submitted herewith.

Petitioners have further declared that their '363 patent specification teaches a combined lithographic/flexographic process having a plurality of successive printing stations for depositing a series of thin, controlled layers of ink or coatings, including, but not limited to, printing color images, on one or both sides of a substrate in a continuous in-line process. In one embodiment of the method of their invention, one of the stations prints a first color image using the flexographic process, and at least one of the successive printing stations prints a second color image over the first color image using an offset lithographic process in the continuous in-line process. Reissue Decl., ¶4. Consistent with the teachings in their specification at col. 2, lines 49-58, reissue applicants teach specifically that in offset lithography, "many sheet fed presses can perfect (print both sides of the paper) in one pass through the press." Id.

Petitioners have noticed several potential errors in the '363 patent.

A. The Possible Misinterpretation of the Term "Over"

First, Petitioners further declare that in one embodiment of their invention, after one side of the substrate is printed or coated using the flexographic process, the reverse side of the substrate may be printed subsequently by lithography. Petitioners believed as of both the filing of their application and the issuance of the '363 patent that the independent and dependent claims clearly covered such an embodiment. Petitioners believed that to one of ordinary skill in the printing art, the language of printing "over" the substrate (see col. 5, lines 29 and 43), as well as other uses in the specification of the term "over" (e.g., col. 5, line 38 and col. 6, line 3), clearly

[illegible]

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Mr. Prince is senior technical consultant in the Technical Services Group at the Graphic Arts Technical foundation in Sewickley, Pennsylvania. Mr. Prince graduated in printing management from Rochester Institute of Technology receiving a Bachelors of Science degree and has received a Masters of Science degree from South Dakota State University. He is an expert in the printing arts. Mr. Prince was asked to review U. S. Patent 5,630,363 and give his opinion as to its teachings to one of ordinary skill in the printing arts, and to respond to specific questions concerning (1) the teaching of the sentence of col. 1, line 54-55 ("Many sheet fed presses can perfect (print both sides of the paper) in one pass through the press.") as that sentence impacts the scope of the invention taught to the printing artisan, and (2) the correct interpretation of the term "over" in the specification and claims.

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Regarding U.S. Patent No. 5,630,363 and the use of the word "over," Mr. Prince offered the following thoughts: The word "over" when used in the Graphic Arts Industry has many meanings. In the '363 patent it is used in two ways, namely (First) one ink printing over (on top of) another ink, coating, colorant or substrate, and (Second), ink, colorant, or coating being printed on both sides of the sheet or substrate. Prince Decl., ¶3. Specifically, as of August 14, 1995 – and the same is true today – the term "over" means to one of ordinary skill in the printing art reading the '363 patent either "on top of" (i.e., the same side of) the substrate, or paper, or by the reference in the paragraph at col. 2, lines 49-58 to the term "perfect" with respect to offset lithography, printing on the reverse side. The claims which refer to printing in a subsequent station "over" an image previously printed means unequivocally either "on top of" or "the reverse side of." *Id.* To amplify the points Mr. Prince offered the following:

(1) In the first meaning we commonly use the word over when describing overprinting or what a printer would call trapping of an ink. The term refers to the transfer of a coating, ink, or other colorant to the surface of another coating, ink, colorant or substrate. The coating, ink, or colorant may be wet or dry. This term has been in common usage since at least 1920 in this regard and very possibly earlier.

(2) In the second meaning the word over describes the printing of a coating, ink, or colorant on both sides of the paper or substrate during one pass on a printing press. This can be accomplished in many ways: (a) the use of a blanket to blanket web press, (b) the use of a double ending hardback web press, (c) the use of a perfecting unit placed anywhere on a sheetfed press, (d) the use of a back printer on a sheetfed press located on any unit of a sheetfed press. The term in this case has been in use since 1880 in this regard and possibly earlier.

To expert Prince, the terms "perfect" or "perfecting" in the art teaches one skilled in the art several options of printing on both sides of a substrate. One option is to "tumble" the substrate in order to print on the reverse side. Prince Decl., ¶4.

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As Mr. Prince reads the '363 patent, it covers all of the various ways a printer would apply a coating, ink, or colorant to another coating, ink, colorant, or substrate to form an "image" Prince Decl., ¶5.

B. The Error in Claims 29 and 34

Petitioners further noticed the errors in independent method claim 29, containing the term "on top of" in the last step (col. 11, line 54) and in related dependent claim 34, containing the broader term "over" (col. 12, line 6). Hence the dependent claim is broader than the claim it depends on. Such errors render claim 29 partially inoperable, and claim 34 potentially invalid. Such errors were inadvertent, and occurred without deceptive intent, for which reissue applications seek correction. Reissue Decl., ¶6.

C. The Possible Misinterpretation of "Image"

Petitioners are concerned that certain of their claims, e.g., claim 1, may be misunderstood as limiting the interpretation of the term "image" to ink, and worse yet, a color ink. Consistent with the specification, e.g., col. 1, lines 18-25; col. 4, lines 12-13; col. 6, lines 46-47, newly presented claims 44-84 require that surfaces at each station be deposited with thin layers of ink or coating materials so that any ambiguity is avoided. Reissue Decl., ¶7.

D. Stenographic Errors

Stenographic errors occurred in the original patent in the spelling of "Pantone" under "Other Publications" listed as prior art, and of the spelling of "flexographic" at col. 1, line 20. Both errors occurred inadvertently and without deceptive intent. Reissue Decl., ¶8.

Petitioners are informed that under 37 C.F.R. § 1.56(a) that a duty of candor and good faith toward the United States Patent and Trademark Office ("Office") rests on the inventors, on each attorney or agent who prepares or prosecutes the application and on every other individual who is substantively involved in the preparation of prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application. Reissue petitioners are now further aware that all such individuals have a duty to disclose to the Office information that each is aware of which is

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material to the examination of the application and that such information is material where there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent. Reissue petitioners further understand that the duty is commensurate with a degree of involvement in the preparation or prosecution of the application. Reissue petitioners are now informed that the duty of disclosure may extend to their own activities prior to the filing date of the application leading to the '363 patent. Reissue Decl., ¶3.

II.

PETITIONERS HAVE SUBMITTED A PETITION TO EXPUNGE

Since the issuance of their '363 patent, Petitioners have been contacted by a domestic manufacturer who has informed them they believe that an inventorship problem exists concerning the '363 patent. A declaration of Petitioners and exhibits thereto is submitted in a sealed envelope and sought to be expunged pursuant to the provisions of 37 C.F.R. §1.57(b) and M.P.E.P. §§724.05 and 724.02.

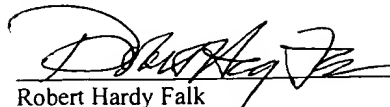
III.

COMPLIANCE WITH 35 U.S.C. §251 AND REGULATIONS

In this Reissue Application, Petitioners Bill L. Davis and Jesse S. Williamson and their assignee Williamson Printing Corporation have made every effort to comply with the pertinent regulations of Title 37, Code of Federal Regulations. Assignee has submitted an Order for a Title Report pursuant to 37 C.F.R. §1.171, and an Assent of Assignee for Reissue of U.S. Patent 5,630,363, pursuant to 37 C.F.R. §1.172. As indicated above, Petitioners Davis and Williamson have submitted a Reissue Declaration pursuant to 37 C.F.R. §§ 1.172 and 1.175. A cut-up specification in compliance with 37 C.F.R. §1.173, including drawings, is submitted. Assignee further submits its Offer to Surrender U.S. Patent 5,630,363, pursuant to 35 U. S. Patent 5,630,363, pursuant to 35 U.S.C. §252 and 37 C.F.R. §1.178.

Early allowance and passage to issue of the instant application is earnestly requested.

Respectfully submitted,



Robert Hardy Falk

Registration No. 27,877

FALK & FISH, L.L.P.

A Texas Limited Liability Partnership

700 North Pearl Street, Suite 970, LB 366

Dallas, Texas 75201

Telephone: (214) 954-4400

Facsimile: (214) 969-5941

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